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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/506,430	02/17/00	GREEN	[illegible]

HM12/0524

Townsend And Townsend And Crew
Steuart Street Tower 20th Floor
One Market Plaza
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EXAMINER	
LUKTON, [illegible]	

ART UNIT	PAPER NUMBER
[illegible]	3

DATE MAILED: 05/24/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applic[illegible](s)
09/506,430	Green
Examiner	**Group Art Unit**
David Lukton	1653

☒ Responsive to communication(s) filed on *Feb 17, 2000*

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 30 DAYS month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-17* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *1-17* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

A restriction is imposed, as set forth below. First, however, the following subgenera are defined:

G1: the pathological condition is limited to the following: hemangiomas, malignant and benign tumors, tumors of the meninges, intracerebral tumors, sarcomas, osteosarcomas, soft tissue tumors, tumors of the eophagus and tumors of the trachea

G2: the pathological condition is limited to the following: chronic liver infection, chronic hepatitis, substance-induced neovascularization of the liver, angiogenic dysfunction related to an excess of hormone, angiogenic dysfunction related to an excess of estrogen, neovascular sequelae of diabetes, central serous chorioretinopathy

G3: the pathological condition is limited to the following: neovascular sequelae to hypertension, neovascularization in a post-recovery cerebrovascular accident, neovascularization due to head trauma, restenosis following angioplasty, neovascularization due to heat or cold trauma

G4: the R'-Glu-Trp-R" dipeptide is limited to the following:

His-Glu-Trp	Cpr-Glu-Trp-OH
Glu-His-Glu-Trp	But-Glu-Trp-OH
Gly-Glu-Trp	Arg-Lys-Glu-Trp-Tyr
Glu-Trp-Lys-His-Gly	Arg-Lys-Glu-Trp
Glu-Trp-Lys-Lys-His-Gly	Lys-Glu-Trp-Tyr
Glu-Trp-NH-NH-Gly-His-Lys-NH_2	Lys-Glu-Trp
Ac-Glu-Trp-OH	pGlu-Trp-OH
Suc-Glu-Trp-OH	Glu-Trp (*per se*)

G5: the R'-Glu-Trp-R" dipeptide can be whatever the claims permit, including G4; however, with the exception of the specific peptides listed in G4, neither R' nor R" can represent a peptide, and neither R' nor R" can contain amino acids.

G6: within the R'-Glu-Trp-R" dipeptide, R' and R" can represent or contain amino acids, with the proviso that subgenus G6 excludes subgenus G5.

*

Restriction to one of the following inventions is required under 35 U.S.C. §121:

1. Claims 1-4, 7-13, 16, 17, drawn to a method of treating a subject afflicted with a condition that includes G1, but excludes G2 and G3, said method comprising administering any peptide, including G5, provided that G6 is excluded, classified in, e.g., 514/19.

2. Claims 1, 2, 4, 6-13, 17, drawn to a method of treating a subject afflicted with a condition that includes G2, but excludes G1 and G3, said method comprising administering any peptide, including G5, provided that G6 is excluded, classified in, e.g., 514/19.

3. Claims 1, 2, 4, 5, 7-13, 17, drawn to a method of treating a subject afflicted with a condition that includes G3, but excludes G1 and G2, said method comprising administering any peptide, including G5, provided that G6 is excluded, classified in, e.g., 514/19.

4. Claim 1, drawn to a method of treating a subject afflicted with a condition that includes G1, but excludes G2 and G3, said method comprising administering any peptide, including G6, provided that G5 is excluded, classified in, e.g., 530/328, classified in, e.g., 514/19.

5. Claim 1, drawn to a method of treating a subject afflicted with a condition that includes G2, but excludes G1 and G3, said method comprising administering any peptide, including G6, provided that G5 is excluded, classified in, e.g., 530/328.

6. Claim 1, drawn to a method of treating a subject afflicted with a condition that includes G3, but excludes G1 and G2, said method comprising administering any peptide, including G6, provided that G5 is excluded, classified in, e.g., 530/328.

7. Claims 14-15, drawn to a method of treating a subject with a binary mixture of active agents, classified in, e.g., 514/19.

The claimed inventions are distinct.

The inventions are distinguished on the basis of the peptides used, and the conditions treated. The restriction is predicated on the view that, notwithstanding the recitation of the term "neovascularization" in the claim, a reference can form the basis for a valid §103 or §102 even if the term at issue is not recited in the document. Thus, a search would have to be conducted for disclosures of Glu-Trp- containing peptides for treatment of one disorder or another, and subsequently a determination made as to whether there are assertions in other documents that angiogenesis or neovascularization is peripherally involved in the etiology or progression of the disorder in question. Thus, while a search in parent application 08/614,764 (now USP 5,902,790) could have been limited to documents that recite the term "neovascularization", such is not the case here.

In the event that any of Groups 1-3 is elected, and claims therein found allowable, Group 7 will be rejoined for further examination (subject to the same limitations).

Applicant is advised that for the response to this requirement to be complete, an election of the invention to be examined must be indicated, even if the requirement is traversed (37 C.F.R. 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

. . . .

In addition to the foregoing, applicants are required under 35 U.S.C. §121 to elect disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The first specie is a specific peptide (presumably Glu-Trp); the second specie is a specific disorder that is the target of the treatment.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

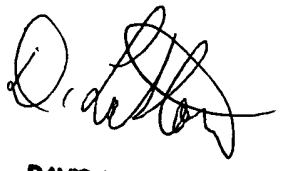
Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are witten in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.

*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



DAVID LUKTON
PATENT EXAMINER
GROUP 1800